

REMARKS

The Examiner has previously indicated that claim 4-6 are in condition for allowance. Applicants thank the Examiner for so indicating. The Examiner again rejected claims 1-3 as allegedly obvious over a computerized printout provided by the Examiner of a Chemical Abstracts entry, Reiter et al., 93:532428. Applicants again respectfully traverse this rejection.

Rejection Pursuant to 35 USC §103(a)

The Examiner has again rejected claims 1-3, this time pursuant to 35 USC 103(a) as allegedly obvious over Chemical Abstracts 532428. This reference discloses that compounds “with diuretic and saluretic activity were prepared” having the structure:



in which R is an optionally substituted phenyl group and R1, R2 and R3 are each selected from a large Markush group of possible substituents. Applicants respectfully traverse this rejection for the following reasons.

The Examiner states that the Applicants’ point that rejected claims are drawn to compositions comprising a single compound and its esters and salts are not well taken because “it is expected that all the species of a genus have similar properties.”

However, the claimed compound does not have these properties, and this is precisely the Applicants’ point. The cited abstract discloses properties (diuretic and saluretic activities) of the cited compounds that the presently claimed compound does not possess. The present compound, an analgesic, is not a diuretic at therapeutic doses.

With this Reply Applicants herewith provide a Declaration of Daniel Gil, Ph.D., which establishes that the compound of claims 1-3 does not possess the diuretic activity described as being a

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defining feature of the compounds disclosed in the Chemical Abstracts entry at analgesic doses.

Accordingly, the cited Chemical Abstracts entry, far from suggesting the presently claimed compound, actually teaches away from the presently claimed compound, since a person of ordinary skill in the art, using the Chemical Abstract disclosure of compounds article as a guide, would not be led to the presently claimed compound.

For this reason, Applicants respectfully ask that the Examiner reconsider the rejection of claims 1-3 and allow all the pending claims to proceed to issue.

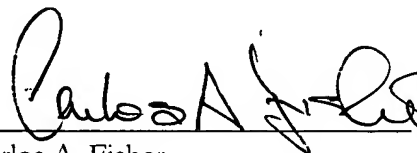
Please charge Deposit Account 01-0885 for the extension fees and any other fees due in this case.

Respectfully submitted,

Dated: _____

9/27/04

By: _____



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